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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 15

Application Number: 09/834,909
Filing Date: April 16, 2001
Appellant(s): LINDH, URBAN

Penny L. Caudle
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2/17/04.

(1)   Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2)   Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly

affect or be directly affected by or have a bearing on the decision in the pending appeal

is contained in the brief.

(3)   Status of Claims

The statement of the status of the claims contained in the brief is correct.

This appeal involves claims 1-20.

(4)   Status of Amendments After Final

No amendment after final has been filed.

(5)   Summary of Invention

**The summary of invention contained in the brief is deficient because it is

directed to the specification rather than the claims**. In particular, "the marketable

value or strength of the patent with respect to other patents of similar technology" [Brief,

bottom page 2] and "statistically displaying cited references and patents that correlate to

each group or subgroup of classified patents" [Brief, page 3 ¶ 2] are cited as the

motivation for the invention.

These elements are tenuous in the claim set at best, and do not appear at least in the independent claims 1, 13 and 20. Thus the discussion of the **claimed** invention is misdirected.

(6) *Issues*

The appellant's statement of the issues in the brief is correct. However, at page 11 of the Brief, a 102(b) rejection is misstated as a 102(a) rejection.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-20 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

Unger et al (Unger)   US 5,721,910   24 February 1998

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

The rejection of claims 1-12 under 35 U.S.C. 101 is hereby withdrawn. The history of this rejection and the reasons for its withdrawal is as follows:

Claims 1-12 were rejected on the grounds that they are general abstractions that fail to fall within the technological arts by being useful in the sense that computer-implemented methods are useful.

[Paper #11]: With respect to the rejection under 35 USC 101, it is agreed that within the context of computer-implemented inventions, terms such as *parameter, file, link, database* and *record* have technical meanings that strengthen that framework, and that in that context, *State Street* applies. However, a point of the rejection is that the claim language in and of itself establishes no such context. As an example, claim 1 at least speaks to a library with an index card file, not computerized.

Upon further consideration: It is considered that the statement of the Appeal Brief beginning at the last paragraph of page 10 that includes: "... *when given their ordinary meaning and read in view of the specification clearly define a computer-implemented method which produces a useful concrete and tangible result*" **does limit the claims to a *computer-implemented* method and system** even though this is not explicit in the claims. Thus the rejection under 35 USC 101 is withdrawn.

Claims 1-9, 11-12 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Unger et al (Unger), US 5,721,910, 24 February 1998.

[Paper #8]: As to **claim 1**, Unger imports bibliographic (patent) data from a variety of sources that are linked for this purpose to the internal database to which Unger is directed [COL 3 lines 14-17; COL 6 lines 44-56; Stage I of FIG 1 and the text in general]. Grouping and linking into a spreadsheet or small database is the focus of Unger, dealt with specifically with regard to stages II-IV [FIG 1; COL 5 lines 7-36 and elsewhere.

The linked records are displayed, as noted numerous places, specifically at COL 5 lines 31-36].

[Paper # 11]: The stored categories [FIG 1] at least comprise a parameter file that is clearly linked to the database.

[Paper #8]: As to **claims 2-3**, various levels of analysis in Unger are based on the linking together of a given patent and/or patent family [COL 5 lines 10-15 and elsewhere]. As to **claim 4**, see FIG 2-4 and the corresponding discussion. As to **claims 5-6**, Unger directs the system at the specific interests of users [COL 5 lines 37-51 and Stage IV in general].

The elements of claims 7-9, 11-12 and 20 are rejected in the analysis above and these claims are rejected on that basis.

Claims 10 and 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Unger et al (Unger), US 5,721,910, 24 February 1998.

[Paper #8]:

As to claim 10, Unger gathers data into spreadsheets [COL 5 lines 7-11], and displays data according to a user's preference selection (as noted in numerous places), but does not specifically state that data is *displayed* as a spreadsheet.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide such a display because it is efficient to display data in a form in which it has been explicitly organized; the lack of such a display would tend to defeat the purpose of a spreadsheet, which is bound to its display.

As to claim 13, Unger does not specifically state that an *internal parameter* is used to link groupings of data.

However, it is inherent that the mechanism used in Unger is internal, and there are well known parameters that bind together patents and patent families, such as an identifying number of the family parent patent or application. In any case, some common attribute or identifier is required to distinguish members of a group from others.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use an internal parameter as a common link because it provides a means of specifying a common attribute or identifier.

As to **claims 18-19**, patents themselves include priority data and the references cited. The references that cite a patent are retrieved by well known commands in patent search engines, such as **.UREF.** in the patent office search engines.

The elements of claims 14-17 are rejected in the analysis above and these claims are rejected on that basis.

[Paper #11]:

As to the rejection under 35 USC 103 using Unger et al (Unger), US 5,721,910, the purpose of a spreadsheet is to form an interactive display, as noted in the rejection. Further, it is inherent in the design and purpose of a spreadsheet that it is configured *in accordance with a user's preference selection*. In particular, this includes the format of cell entries, numbers of rows and columns, labels of rows and columns, algebraic functions that determine cell values, width and spacing of cell boundaries, and the like, and particularly the sorting of column and row values, all of which are determined by the user either before or after the spreadsheet is loaded.

It is considered that Unger did not need to explicitly address these issues in part because one of ordinary skill in the art would not need them as explicit teachings.

(11) Response to Argument

35 USC §102 [claims 1-9, 11, 12 and 20]:

The Specification at [0029] states:

"The parameter file is based on the bibliographical information of the data obtained. This

usually includes the title, access number and/or **classification** code. However, **any**

bibliographical information can be used in the parameter file." [Emphasis added.]

This reduces to the statement that a parameter file is one based on any

bibliographic information. Applicant fails to recognize the breadth of this characterization

in the arguments and interpretations of the claims.

The Brief states: "*However, nowhere in Unger is there any disclosure or

suggestion of a parameter file as claimed.*" [Page 12 ¶ 12]

It is immediately clear from FIG 1 at least of Unger that there are a number of

data sets used by Unger that correspond to the contents of such a "parameter file,"

including the stored categories explicitly noted in the final rejection *supra*. Applicant is

apparently dependent on the semantic import of the word "file" to distinguish over

Unger. However, Unger is explicit about selecting from subsets of the categories [COL 3

lines 55-59], which implies that the categories are a data set accessible as a whole,

which corresponds to a file. Furthermore, a list of search parameters corresponds to a

parameter file and Unger addresses searches for categories of data as a common

thread [COL 4 lines 32-43 and elsewhere].

The applicant is responsible for the four corners of the reference, and there are a

number of other accessible parameter data sets in Unger as well [See COL 4 lines 43-

57, where subject-specific tables are discussed].

The other aspect of the use of the parameter file addressed in the brief is its use

to **import** patent data into an internal database as in claim 1.

Unger addresses the selection of subsets of documents and/or categories as

noted above, and then goes on to explicitly import documents from a wide variety of

clearly external sources [COL 3 line 60 to COL 4 line 7]. Further, an individual scientist

or engineer may retrieve subsets and group them into subject-specific tables to analyze

them [COL 4 lines 43-57]. The selection of subsets process creates a (sub-) database;

the importation from external sources is clearly controlled by both category and subject-

specific information.

35 USC §103 [claims 10 and 13-19]:

Applicant consistently applies a 35 USC §102 standard to a §103 rejection, and

at places applies the standard of requiring a literal exhibit of the claim language within

the reference. There is no justification in case law for these standards.

At page 13 of the Brief Applicant states: "However, as discussed in §2143.01 of

the MPEP, the mere fact that a reference can be modified does not render the resultant

modification obvious unless the prior art also suggests the desirability of the

modification" This leaves out crucial caveats, set forth in §2144 of the MPEP: "The

rationale to modify or combine the prior art does not have to be expressly stated in the

prior art; the rationale may be expressly or impliedly contained in the prior art or it may

be reasoned from knowledge generally available to one of ordinary skill in the art,

established scientific principles, or legal precedent established by prior art cases."

Much of the argument about **claims 10 & 16** is directed to spreadsheet

technology, centered on *"data is displayed as a spreadsheet"*.

A spreadsheet is a visual instrument that is designed to support extensive customized formatting, as one of almost any skill in the art would be aware. There is no reason for Unger to be explicit about that.

It is noted that the graphical displays supported by spreadsheets are themselves spreadsheet displays, chosen by the user. It is not clear what distinction Applicant is drawing with the displays of Unger. The obviousness statement of the rejection was recognition that Unger was not explicit, and only applies to the extent that Unger does not anticipate the claim language *per se*, as opposed to the invention described by the claims.

Moreover, it is not clear how a spreadsheet can be set up or properly defined without an interactive display. In this sense, a spreadsheet is bound to its display even though a spreadsheet also provides for other summaries of data and data relationships, such as graphs. No explicit prompting of the various aspects of a spreadsheet required for claims 10 and 16 is required for it to be obvious to one of ordinary skill, even if it is not actually inherent in the spreadsheet context.

Applicant faults the rejection of **claim 13** with: ... *Unger fails to disclose a selection component that allows a user to select particular data of a record and the format of the record for display.* The entire content of Unger would be nonsense if this was not an understood goal of its teaching. As one citation that is pertinent, consider COL 4 lines 44-57, which includes:

An individual scientist or engineer may then evaluate each patent in a particular

group and capture the essential details of each invention into a subject-specific table

which can be linked back to the original documents and/or abstracts to the original

characterization. This is followed at COL 4 line 62 *et seq* by: *Stage I and II represent*

well known methods of dealing with collections of full-text patents and semi-organized

analyses of those collections of patents in the form of spreadsheets and small

databases. In particular, one of ordinary skill would have been very familiar with

spreadsheets and aware that one central purpose of a spreadsheet is to display the

organization of data within the spreadsheet *in accordance with a user's preference*

selection [as in claim 10].

The statement in the Brief at page 15 ¶ 2: is in contradiction to the features of

spreadsheets in general noted by the Brief itself. To iterate the rejection, "Stages I and II

of Unger represent well known methods of dealing with collections of full-text patents ...

in the form of spreadsheets or small databases" [COL 4 lines 62-65]. It is clear that the

totality of spreadsheet technology is intended. It is difficult to understand how the

statement cited *supra* could do anything else. **The obviousness statement of the**

rejection was addressed to the use of an *internal parameter*, which is evidently

not in dispute.

As to **claim 18**, the Brief at page 15 ¶ 3 states: "... claim 18 recites that a user

can prioritize the imported data, not that the data includes priority information with

regard to patents."

All of Unger addresses this aspect of the invention and some citations above have addressed it, but attention is drawn to COL 6 lines 44-56, where Stages II through VI may be used to identify patents and/or technical documents of particular interest for a particular application." Determination and/or selection and/or identification of patents of particular interest clearly involve one or more indications of priority. Unger is directed among other things [COL 4 lines 49 – 53] "to group similar patents together". Clearly references cited by a patent fall within such a group. Further, the subject-specific tables used for analysis are linked back to original documents. One of ordinary skill in the art is well aware that in the patent system, priority documents must be noted in order to have a complete record of the significance of a patent. The term "mark" in the claim is very broad.

As to **claim 19**, Applicant again fails to recognize the state of the art at the time of the invention. As noted in the rejection, the number of citations of a document was of significance in searching at the time of the invention. It was also of common interest in legal citations, scientific paper valuations, and the organization of the World Wide Web. The use of this feature is so ubiquitous that one of ordinary skill in the art at the time of the invention did not require its explicit mention as a potential parameter of interest in order to recognize its utility.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

WPA
May 17, 2004

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